

**REMARKS**

Claims 1, 3, 4, 6, 7, 9, 10, 11 are pending in this Application with Claims 2, 5, 8 deleted, with Claims 1, 3, 6 being amended and Claim 21 is being added to further clarify the invention. No new matter is added by way of these amendments, and the amendments are supported throughout the Specification and the drawings. Reconsideration of Claims 1, 3, 4, 6, 7, 9, 10, 11 and favorable consideration of Claim 21 is respectfully requested.

The Examiner's rejections will be considered in the order of their occurrence in the Official Action.

**Paragraph 1 of the Official Action**

The Official Action rejected as-filed Claims 1, 4, 6, 7, 9-11 under 35 U.S.C. §102(b) as being anticipated by **Hindle**. Claim 1 has been amended to include the limitations of deleted Claims 2 and 5. The Applicant respectfully disagrees with this rejection particularly in view of the amendments made to Claim 1.

It is important to first briefly discuss 35 U.S.C. §102 and its application to the present application. Under section 102(b), anticipation requires that the prior art reference disclose, either expressly or under the principles of inherency, every limitation of the claim. But to be prior art under section 102(b), a reference must be enabling. . . . That is, it must put the claimed invention in the hand of one skilled in the art. . . . **The examiner bears the burden of presenting at least a prima facie case of anticipation.** In re Sun, 31 USPQ 2d 1451, 1453 (Fed. Cir. 1993) (unpublished). An anticipating reference must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed and that its existence was recognized by persons of ordinary skill in the field of the invention. ATD Corp. v. Lydall, Inc., 48 USPQ 2d 1321, 1328 (Fed. Cir. 1998).

Under 35 U.S.C. §102, anticipation requires that **each and every element** of the claimed invention be disclosed in the prior art . . . In addition, the prior art reference must be enabling,

thus placing the allegedly disclosed matter in the possession of the public. Akzo N.V. v. United States Int'l Trade Comm'n, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987) (emphasis added). Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. W.L. Gore & Assocs. v. Garlock, Inc., 220 USPQ 303, 313 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, *arranged as in the claim*. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984).

When more than one reference is required to establish unpatentability of the claimed invention anticipation under § 102 can not be found, and validity is determined in terms of § 103. Continental Can Co. USA v. Monsanto Co., 20 USPQ 2d 1746, 1748 (Fed. Cir. 1991).

Section 102(a) establishes that a person can not patent what was already known to others. If the invention was known to or used by others in this country before the date of the patentee's invention, the later inventor has not contributed to the store of knowledge, and has no entitlement to a patent. Accordingly, in order to invalidate a patent based on prior knowledge or use, that knowledge or use must have been available to the public. . . . Therefore, notwithstanding abandonment of the prior use -- which may preclude a challenge under § 102(g) -- prior knowledge or use by others may invalidate a patent under § 102(a) if the prior knowledge or use was accessible to the public. . . . Section 102(b), unlike § 102(a), is primarily concerned with the policy that encourages an inventor to enter the patent system promptly, while recognizing a one year period of public knowledge or use or commercial exploitation before the patent application must be filed. Thus an inventor's own prior commercial use, albeit kept secret, may constitute a public use or sale under § 102(b), barring him from obtaining a patent. . . . However, when an asserted prior use is not that of the applicant, § 102(b) is not a bar when that prior use or knowledge is not available to the public.

Woodland Trust v. Flowertree Nursery, Inc., 47 USPQ 2d 1363, 1365-66 (Fed. Cir. 1998).

Amended Claim 1 contains limitations not shown within Hindle. The Applicant respectfully submits that Hindle does not qualify as appropriate prior art under 35 U.S.C. §102(b) as Hindle does not disclose all of the elements of the amended independent Claim 1.

### **Paragraph 2 of the Official Action**

The Official Action rejected Claims 2, 3, 5 and 8 under 35 U.S.C. §103(a) as being unpatentable over **Hindle** in view of **Schiefer** (Claims 2, 3, 5, 8) or **Terrizzi** (Claim 5). Claims 2, 5, 8 are deleted and incorporated into independent Claim 1. However, the Applicant respectfully disagrees with this rejection as potentially applied to amended Claim 1 and added Claim 21.

In proceedings before the United States Patent and Trademark Office, the Examiner bears the burden of establishing a *prima facie* case of *obviousness* based upon the prior art. In re Bell, 26 USPQ2d 1529, 1530 (Fed. Cir. 1993). In re Oetiker, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). When references cited by the Examiner fail to establish a *prima facie* case of obviousness, the rejection is improper and will be overturned upon appeal. In re Fine, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).

The law regarding *obviousness* is clear -- any modification of the prior art must be suggested or motivated by the prior art. It is submitted that combining elements from different prior art references (in an attempt to establish obviousness) must be motivated or suggested by the prior art.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.’ [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious “modification” of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.”

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

"The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape \*\*\* since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason."

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original).

Amended Claim 1 now has the following limitations:

1. (Currently Amended) A fluid flow bolt, comprising:
  - a shaft having an elongate structure and a head;
  - a plurality of channels extending into an outer portion of said shaft from a distal end of said shaft having a depth D1, **wherein said channels have a spiral pattern and have a V-shaped cross sectional shape;** and
  - a threading within said shaft having a plurality of threading grooves having a depth D2 and threading ridges;said depth D1 is greater than said depth D2.

Hindle teaches a "blade lock screw" having head with a threaded shaft and a plurality of longitudinal channels (rectangular shaped) as shown in Figures 3-5 of the drawings. The Applicant admits that the channels within Hindle are for allowing lubrication fluids to pass through when secured. However, the Applicant respectfully submits that Hindle does not teach the usage of "V-shaped" channels. More particularly, Hindle does not teach the usage of a

plurality of channels having a “spiral pattern” which is another significant limitation within the present invention.

Terrizzi merely teaches a “fastener system with an entrainable function-facilitating material.” Terrizzi does not teach fluid receiving channels for allowing for the free flow of fluids. In addition, Figures 8 and 9 of Terrizzi merely teach a single “reservoir channel” filled with a bonding agent or sealing agent. In addition, Terrizzi does not teach channels that are significantly below the depth of the threading (see Figures 8 and 9). Even if the “function-facilitating material” was removed from the channels within Terrizzi, there would not be sufficient space for allowing fluid to flow. In addition, Terrizzi does not teach the usage of “V-shaped” channels as claimed in Claim 1 and 21. Terrizzi also does not teach 3 channels positioned 120 degrees apart. Finally, Terrizzi is nonanalogous to the present invention as the present invention relates to a “fluid flow bolt” while Terrizzi relates only to a fastener that receives bonding agents, caulking and the like. One skilled in the art of the present invention would not have known about Terrizzi and Terrizzi does not relate to the problems solved with the present invention (i.e. fluid flow).

Finally, Shiefer (another non-analogous reference) merely discloses an “expansion bolt assembly”. Shiefer does not teach V-shaped channels that are in a spiral structure. Also, Shiefer is not related to the present invention. One skilled in the art of the present invention would not have known about Shiefer and Shiefer does not relate to the problem solved by the present invention (i.e. fluid flow).

It should also be noted that Claim 3 has the following limitations: “wherein said V-shaped cross sectional shape has a rounded narrow portion and rounded broad ends.” This structure simply is not shown in the prior art. Please see Figure 4 of the present application to see the “rounded broad ends” not shown in any of the prior art references.

For these reasons, among others, the combination of **Hindle**, **Schiefer**, and **Terrizzi** cannot suggest the combination of features in applicant’s Claims 1, 3, 4, 6, 7, 9, 10, 11, 21,

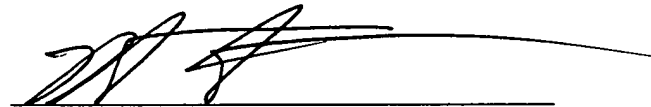
particularly as the same are now amended, and it is therefore submitted that the rejection against these claims should be withdrawn and Claims 1, 3, 4, 6, 7, 9, 10, 11, 21 allowed.

**Added Claim 21**

The Applicant has added independent Claim 21 which incorporates many of the limitations of amended Claims 1, 3, 4, 6, 7, 9, 10, 11. The above-stated reasons, Claim 21 is believed to be in condition for allowance also.

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited. If the Examiner is not completely persuaded by the above arguments and amendments, the Applicant respectfully requests that the Examiner contact the attorney of record, Michael S. Neustel, at 701-281-8822 to discuss an amicable resolution for this application.

Respectfully submitted,



Michael S. Neustel (Reg. No. 41,221)  
NEUSTEL LAW OFFICES, Ltd.  
2534 South University Drive, Suite No. 4  
Fargo, North Dakota 58103

November 3, 2003

Date

Telephone: (701) 281-8822  
Facsimile: (701) 237-0544  
e-mail: michael@neustel.com